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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

JEBENS et al.

Serial No.: 09/731,359

For: DATA MANAGEMENT AND
ORDER DELIVERY SYSTEM

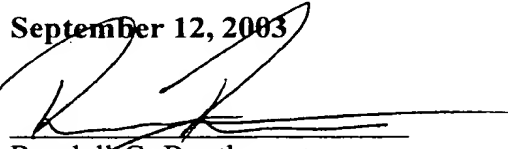
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Group Art Unit: 3624

Examiner: E. Colbert

) I hereby certify that this paper
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) 22313-1450, on this date:

September 12, 2003


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#18
10/23/03

RULE 131 DECLARATION OF JOHN H. JEBENS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Madam:

1. I am one of the named inventors of the above-referenced patent application.
2. I am advised that the attorneys prosecuting the subject patent application recently discovered Sheridan, U.S. Patent 5,760,917 which issued on June 2, 1998 on an application filed on September 16, 1996, and which was cited in an information disclosure statement filed in the subject application.
3. Lowell Carlson, another named inventor of the instant application, originally conceived of the concept of a system including a centralized, secure digital image repository capable of distributing high resolution duplicates of stored images over a wide area network (WAN) on _____, a date long prior to September 16, 1996. (Exhibit A, Page 1).

4. Shortly after conceiving of the system, Lowell Carlson shared his concept with me. I began working with Mr. Carlson to develop the concept into a working system in _____. (Exhibit A, Page 2).

5. After significant development activity and more than one year before the earliest effective filing date of the instant application, we approached Foster & Gallagher in _____ with a sales proposal. (Exhibit B). That sales proposal was directed to the rudimentary predecessor system to the system disclosed and claimed in the instant application as discussed in the information disclosure statement filed on December 6, 2000 in the instant application Serial No. 09/731,359. As shown in Exhibit B, that predecessor system did not accept or compile job orders for routing to another user or device, did not include a routing mechanism for automatically routing images to destinations such as printers, did not include a routing mechanism for routing compiled job orders to user defined locations, did not include a mechanism to permit user defined compression of data stored on the central database as disclosed in the instant patent application, and did not include a mechanism for translating the format of a received file to predetermined format(s). The system of Exhibit B was based on dial-up type connections. If a user desired to direct a high resolution image to a third party, the host system would send a message (e.g., an e-mail, fax, etc.) to the third party requesting the third party to dial-up the host system to retrieve the high resolution image.

6. Foster & Gallagher did not accept the sales proposal.

7. Jeffrey S. James, the third named inventor, joined the development team on _____. (Exhibit A, Page 2). Jeff James and I continued to develop and diligently work to reduce the system to practice.

8. In _____, Monet, the original assignee of the subject patent application, attended the Seybold Show in Boston. (Exhibit C).

9. At that show, we demonstrated a reduction to practice of the rudimentary system described above. Specifically, we demonstrated the centralized, remote storage and image browsing capabilities of the rudimentary system. As discussed above, the system did not have routing capabilities, and no such routing was shown or demonstrated.

10. After the show, Jeff James and I continued to use our best and diligent efforts to develop and enhance the system. As part of those efforts, we developed the data flow chart attached hereto as Exhibit D. Exhibit D is dated _____. It was never distributed or published, but was used for internal purposes.

11. Our efforts to develop the system continued. System screen shots from sometime after _____ showing an intermediate result of those efforts are attached as Exhibit E. The updated system documented by Exhibit E was a dial-up type system and did not offer the automatic routing capabilities mentioned in paragraph 5 above.

12. I prepared a white paper dated _____ which is attached hereto as Exhibit F. That white paper documents our continuous, diligent efforts to develop and reduce the invention to practice. Those efforts are also demonstrated by Monet's efforts to develop beta sites to test the system in development. Beta sites were installed at Boston Photo in Boston, Massachusetts and Quantech of Milan, Illinois in _____. (Exhibit A, Page 3). Beta sites were also installed at McKay Communications of Midland, Michigan on _____, and Amana Appliances in _____, and at three advertizing agencies in _____. (Id.) These systems did not offer the routing capabilities discussed in paragraph 5 above.

13. On _____, a date prior to September 16, 1996, a system constructed in accordance with the teachings of the invention was announced. (Exhibit G). On December 6, 1996, Monet supplemented that announcement with a document describing the Monet system. (Exhibit H). Unlike the earlier system described above, the system

described in Exhibits G and H had the routing capabilities described in paragraph 5 above. Also, unlike the earlier system, this system was Internet compatible. (Exhibit G, Page 2 and Exhibit H, Page 49). This system did not rely solely on dial-up connections. It accepted work orders from users, developed job orders including high resolution image(s) specified in the work order, and automatically routed the job order including the high resolution image(s) to third parties. Thus, for example, a user who had stored a digital image on the Monet server contemplated by Exhibits G and H could: (a) download a low resolution copy of the stored digital image, and (b) send a work order to the Monet server identifying a stored image and requesting that the image be printed. The Monet server responded to such requests by compiling a job order including data from a high resolution image corresponding to the image identified by the work order and routing the job order to a printer for printing.

14. Subsequently, I began diligently preparing a patent disclosure document (Exhibit I) describing the system in detail. That disclosure document was completed on April 24, 1997. After interviewing potential law firms, we retained Marshall, O'Toole, Gerstein, Murray & Borun in May of 1997 to prepare a formal patent application. I diligently worked with patent counsel to initiate a patentability search, to review the results of the search and to complete and file the subject patent application on August 11, 1997.

15. The database management system contemplated in Exhibits G and H included (1) an electronic storage facility for providing storage for digital assets of a plurality of unrelated asset provider users, at least some of the digital assets stored in the electronic storage facility including first sets of data each having a first bandwidth communication requirement and second sets of data each representative of an associated one of the first sets of data and having a second bandwidth communication requirement less than the first bandwidth communication requirement, the electronic storage facility storing the digital assets of a first one of the asset provider users such that the digital assets of the first asset

provider user can only be accessed by authorized users identified by the first asset provider and such that the digital assets of the first asset provider user are transparent to users that are not authorized by the first asset provider user; (2) means for allowing an authorized user identified by the first asset provider to download a particular second set of data from a storing means to a first location; (3) means for accepting a work order from the authorized user at the first location wherein the work order identifies a second location as an intended destination of the work order, identifies the particular second set of data, and further includes data developed outside the system; (4) job order development means responsive to the accepting means for developing a job order including both (a) the first set of data associated with the particular second set of data and (b) the data developed outside the system; and (5) means for automatically electronically routing the developed job order to the second location.

16. The database management system of Exhibits G and H also included file format translation capabilities. In particular, the system was adapted to translate new image files received from a user into a predetermined file format. For example, a user could upload an image file in tagged image file format. Upon receiving the new image file, the server would determine whether the new file is in a predetermined format (for instance, the JPEG format). If not, the server translated the new image file into the predetermined file format. If the new file received from the user was already in the predetermined file format, the server did not perform a translation. A similar file format translation process could be used when downloading files from the centralized storage facility to translate files into desired formats.

17. Although some of the above dates have been redacted from this declaration and the corresponding exhibits, all of the redated dates occur prior to September 16, 2000, the filing date of U.S. Patent 5,760,917.

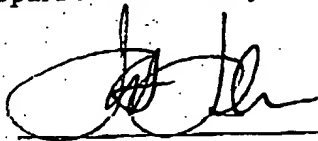
18. I understand that willful false statements and the like are punishable by fine and/or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and

that any such willful false statement may jeopardize the validity of this application and any patent resulting therefrom:

Date:

18 Sept 43

By:



John H. Jebens